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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,873	12/31/2001	Meinolf Dingenotto	F-744 C	4655

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EXAMINER

PRASAD, CHANDRIKA

ART UNIT

PAPER NUMBER

2839

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,873

Applicant(s)

DINGENOTTO ET AL.

Examiner

Chandrika Prasad

Art Unit

2839

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 March 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-10 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. 09/479,022.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____ .

DETAILED ACTION

Response to Amendment

1. The reply filed on 03/20/03 consists of amendments to both independent claims 1 and 6; addition of new claims 9-10; and remarks related to rejection of claims. The claims are not allowable as explained below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2 and 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by

Plass.

Plass (Figures 1 - 9) shows a monolithic planar filter 10 having capacitance for a multipole angle socket connectors; a plurality of signal electrodes 16 for connecting to conductor pins 6.1, 7.1, 12.1 arranged in rows and columns; a ground electrode 14 wherein the ground electrode is applied and covers one planar side surface of a block-shaped base (dielectric layer) 15 of a ceramic material having pin lead-through holes and the signal electrode is applied on the other planar side surface of the dielectric layer 15 extending from the pin lead-through leads, and a supporting plate 11 attached directly to the filter 10. The supporting plate is made of aluminum oxide, which has a dielectric constant lower than that of the dielectric layer, which has a titanate base. All the layers and the supporting plate have through holes for the conductor pins to pass through, and the openings have soldered portions 16.1. The electrodes 16 are formed in a way to provide a clearance around the through holes for the

solder to be drawn into the holes for fixing the signal pins. The pins are soldered at one end and the other end having a connector.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Plass.

Plass shows all the features of this claim as described in Paragraph 3 above except the material of the base. It would have been obvious to one having ordinary skill in the art at the time of the instant invention to make the base of strontium titanate because it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

7. Applicant's arguments filed 03/20/03 have been fully considered but they are not persuasive.

The applicant argues that in Plass the signal electrodes are applied immediately on the support layer to form planar filter. This is not true. The signal electrodes 16 are not applied to the support layer 11, rather it is applied to the base 15 to form filter. The applicant argues that the instant invention has a plurality of trough openings, but no such feature is found in any of the claims. Plass shows the planar filter disposed directly and closely to the support plate 11 and the surfaces of the support plate are flat. Plass shows all the features as claimed in Claims 1-10 as described in Paragraphs 3 and 5 above. The applicant's arguments about checking before assembly of the final product is not supported by claim language. The applicant has not clearly identified what items are not taught by Plass.

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad at (703) 308-0977. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached at (703) 308-2710. The fax number for this Group is (703) 872-9318 (general) and (703) 872-9319 for after-final. Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-1782.


Chandrika Prasad
Patent examiner
April 1, 2003